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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/764,748	01/18/2001	Jonathan E. Lowther	INTL-0511-US (P10480)	7988
21906	7590	12/27/2005	EXAMINER	
TROP PRUNER & HU, PC 8554 KATY FREEWAY SUITE 100 HOUSTON, TX 77024			BUI, KIEU OANH T	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 12/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/764,748

Applicant(s)

LOWTHERT ET AL.

Examiner

KIEU-OANH T. BUI

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 October 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 31-60 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 31-60 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/05/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/05/05 has been entered.

Remark

2. Claims 1-30 were canceled. New claims 31-60 are added for examination.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 31 recites the limitation "said receiver" in the claim. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections – 35 USC 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

*A person shall be entitled to a patent unless –
(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.*

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6. Claims 31-60 are rejected under 35 U.S.C. 102(e) as being anticipated by Srinivasan et al. (U.S. Patent No. 6,357,042 B2).

(Please note the examiner considers and examines a set of system claims 51-60 first as for the main concept of the present application; and claims 31-50 are for its corresponding method and a computer medium for storing instructions thereof).

Regarding claim 51, Srinivasan discloses a system (Fig. 12) comprising:

a receiver to receive content including an interruptible content portion and an advertisement, i.e., Figs. 1 for a set top receiver and/or receiver 119 of the set top (Fig. 12) for receiving content including an interruptible content (which content can be interrupted during play) and an advertisement (col. 6/lines 19-52 for a plurality of sources for providing contents to the set top box and the contents can be interrupted by other contents such as an advertisement, and col. 30/lines 53-62 for contents includes advertisements regarding as “interrupting contents”);

a cache, coupled to said receiver, to store said content and advertisement (Fig. 12, item 117 for a CPU containing a cache for storing content and advertisement (refer to col. 20/lines 54-65); and instructions that enable said receiver to associate an advertisement with said cache content and collect information to enable a credit to a content provider for an advertisement displayed in association with said content (col. 31/line 5-29 for ad insertions; col. 34/lines 1-23, more ads means more charges to advertisers and means more credit to providers).

an interface, in said receiver, to find a place to insert an advertisement in said portion while said portion is still stored in said cache, insert said advertisement in said portion, and output for display”, i.e., pipeline 129 regarding as an interface comprising buffers 131 and 133

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and together with the software provided for controlling and finding the place to insert the advertisement in the cached content or the portion still stored in the cache by performing synchronization of stream data using time marker and frame numbers before combining and displaying to the user using the display module (Fig. 12 and col. 21/lines 27-67).

As for claim 52, Srinivasan discloses “wherein said system is a television receiver” (Fig. 12 for system 115 with television port at 119 as television receiver).

As for claims 53-55, Srinivasan further discloses a device that “wherein said cache stores instructions that enable the receiver to identify an advertisement that is proximate in time to the content”, i.e., content and control information is collected, analyzed and determined based on user’s preferences for effectively targeting viewers with appropriate programs (col. 31/line 15 to col. 32/line 40 for various of examples and situations for when and how the ad server inserts appropriate ads to target the viewer based on their profile during appropriate time slots and etc.); and “to accrue credit to a content provider of content that is proximate to the advertisement and based on upon the amount of content selected for play on the receiver” (col. 34/lines 1-23, more ads means more charges to advertisers and means more credit to providers based on the amount and selection of content that is proximate to the advertisement, noted in col. 2/lines 50-62).

As for claims 56-57, Srinivasan teaches these feature as addressed in claim 55 above and further in col. 31/lines 15 to col. 32/line 11 as the ad insertion can be determined or predetermined based on numerous factors about what content was played with an advertisement, also means to identify an advertisement to associate with the content i.e., preference and/or profile and/or synchronization/matching contents, buying time slots etc., also noted in col. 2/lines 50-62 and col. 32/lines 41-56.

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As for claim 58, Srinivasan further discloses wherein the receiver to insert the advertisement in the content in response to the detection of a pause in the playback of the content (col. 31/lines 15-29 for blank segments and the system can insert ads there; and in col. 32/lines 12-40 as the user pause the playback and initiates to order a new service or program or request an updated URL link, the system can insert the ad therein).

As for claim 59, Srinivasan further discloses "wherein said interface to allow limited access to said content" (col. 31/lines 58-64, if the user orders a particular VOD program, he/she is limited to the ordered program only).

As for claim 60, Srinivasan further discloses "wherein the receiver enables a variety of content to be selected for play at any time" (col. 33/line 58 to col. 34/line 38-67 for the user can add a wide range of content providers if he prefers and he can access for play at any time).

As for claims 31-40 and 41-50, these claims (of the claimed system) for a corresponding method and corresponding computer medium for storing instructions are rejected for the reasons given in the scope of system claims 51-60 as disclosed in details above to avoid unnecessary repetitions, not limited to the cited paragraphs above but also to the entire disclosure and teaching of the Srinivasan reference.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gaske et al, Hodge, and Bonomi et al (PTO-892 attached) disclose systems related to providing content and advertisements.

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8. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

or faxed to PTO New Central Fax number:

(571) 273-8300, (for Technology Center 2600 only)

*Hand deliveries must be made to Customer Service Window,
Randolph Building, 401 Dulany Street, Alexandria, VA 22314.*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to "Krista" Kieu-Oanh Bui whose telephone number is (571) 272-7291. The examiner can normally be reached on Monday-Friday from 9:30 AM to 7:00 PM, with alternate Fridays off.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kieu-Oanh Bui
Primary Examiner
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KB

Nov. 19, 2005